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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,527	03/15/2004	Earl Grim	98150C.PUS	1312

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EXAMINER

BLAU, STEPHEN LUTHER

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 12/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/800,527

Applicant(s)

GRIM, EARL

Examiner

Stephen L. Blau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3 and 6-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3 and 6-13 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: Adding provisional applications numbers 60/136,968 and 60/210,699 to page 1 of the specification claiming benefit to is disagreed with. A non-provisional application can only claim benefit to a provisional application if the non-provisional application is filed within 12 months of the filing of the provisional application (See 35 U.S.C. 119 (e)(1)), Article 201.11 (MPEP)). The parent non-provisional application (10/162,959) was filed on 5 June 2002 and as such can only claim benefit to any provisional applications which were filed within 12 months of this date. Provisional application 60/136,968 was filed 1 June 1999 which is greater than 12 months from 5 June 2002 and provisional application 60/210,699 was filed 8 June 2000 which is also greater than 12 months from 5 June 2002. As such these applications need to be removed from page one and only provisional application 60/295,882 should be added.

Appropriate correction is required.

2. The abstract of the disclosure stands objected to because in page 7 lines 12-17 the description of figure 6 is inaccurate in that a photo is being discussed. Figure 6 does not have a photo. Correction is required. See MPEP § 608.01(b).

Claim Objections

3. Claim 6 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The element of structure claimed in claim 6 is already claimed in claim 3 which claim 6 depends on.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 3, and 6-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 3 refers to descriptions as shown in a figure which causes the claims to be indefinite in that it is uncertain what the limits of the claim are. Figures should not be referred to in claims. All structure should be positively defined. Claim 3 is indefinite in that in line 9 the terms "and whose are is" does not make sense. Claim 3 is indefinite in that there are two commas next to each other in line 8 now that the letters "NR" are removed. Also in claim 3 line 8 at the second

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occurrence of the word “radius,” the commas before and after this word does not make sense.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3, 6 and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masghati in view of Hueber and Toulon or Hasebe.

Masghati discloses a height of a clubface (Fig. 16), a lie angle able to maintain an impact point of a golf ball on a face when the impact point is offset a center of mass in the form of a golfer able to hit a ball off center and still on the face (Fig. 9), a metal wood (Col. 6, Lns. 53-58), a driver (Col. 6, Lns. 28-33), a mass concentration higher in a toe and than a heel (Figs. 17,19), a heel to toe bulge (Fig. 7) whose center is square to the face in the orientation as shown in figure 16, an elliptical zone on a face whose major axis is generally perpendicular to a shaft able to produce the same distance in the form of a golfer being able to vary a swing to produce the same distances for different points on a face and an elliptical zone can exist on all golf club faces, and a line tangent to the top edge of a club face being tilted upwardly towards the toe at an angle greater

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than 2 degrees to the horizontal in the form of there are an infinite number of tangent lines including a greater than 2 degree line at a top edge of a club face due to the top face edge curving (Fig. 16).

Masghati lacks a height of a clubface as measured from a top edge to a sole edge at its greatest point being greater than 47 mm and a lie angle being greater than about 60 degrees.

Hueber discloses metal woods having a lie angle being greater than about 60 degrees (Claim 13) and a driver having a lie angle of 60 degrees (Table 3) in order to have a club which is able to hit shots which standard clubs are not designed to provide [0004]. In view of the publication of Hueber it would have been obvious to modify the club of Masghati to have a metal wood or Driver having a lie angle greater than about 60 degrees in order to have a club which is able to hit shots which standard clubs are not designed to provide.

Hasebe (Fig. 5) or Toulon (Table I) disclose a height of a clubface as measured from a top edge to a sole edge at its greatest point being greater than 47 mm. In view of the references of Hasebe (Fig. 5) or Toulon (Table I) it would have been obvious to modify the club of Masghati to have a height of a clubface as measured from a top edge to a sole edge at its greatest point being greater than 47 mm in order to have a large face for a golfer so during miss-hits a ball is still impacted.

Since this is an apparatus claim weight is given to what the club is. Very little weight is giving to how it is made or how it is used (Claim 10).

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Masghati in view of Hueber and Toulon or Hasebe as applied to claims 3, 6 and 8-11 above, and further in view of Nishimura.

Masghati lacks a club having a shaft length measured from a heel end of the sole to the butt end being between about 39 and 48 inches.

Hueber discloses a shaft length about 39 inches in the form of 38.5 inches (Table 3). In view of the publication of Hueber it would have been obvious to modify the club of Masghati to have a shaft length of between about 39 and 48 inches in order to maximize head velocity at impact when playing a round of golf. Nishimura discloses a club head having a shaft which contacts the sole of a head (Fig. 1) in order to prevent a shaft from bending and to solidly secure a shaft to a head (Col. 1, Lns. 30-60). In view of the patent of Nishimura it would have been obvious to modify the club of Masghati to have a shaft length measured from a heel end of the sole to the butt end by having a club length the same as a shaft length in order to prevent a shaft from bending and to solidly secure a shaft to a head.

9. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masghati in view of Hueber and Toulon or Hasebe as applied to claims 3, 6 and 8-11 above, and further in view of Galloway.

Masghati lacks clubface design with a thickness distribution so to optimize performance in an elliptical zone.

Galloway discloses a metal wood having a mass distribution of a head concentrated in a toe and heel and periphery of a head in the form of a hollow metal head (Fig. 4), a heel to toe bulge (Fig. 4), and a clubface design with a thickness distribution so to optimize performance in an elliptical zone (Figs. 1, 5) in order to have a face which corresponds to ball impact probability points. In view of the patent of Galloway it would have been obvious to modify the club of Masghati to have a clubface design with a thickness distribution so to optimize performance in an elliptical zone in order to have a face which corresponds to ball impact probability points.

Response to Arguments

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10. The argument that the Exhibits 1 and 2 with the Declaration dated 22 June 2005 eliminates the prior art patents is disagreed with. In order to swear behind the references used it must be shown that all elements of structure claimed in claim 3 was known prior to the date of the reference. In reviewing Exhibits 1 and 2 the examiner was unable to find the following elements of structure in claim 3.

- a. "mass distribution of a head being concentrated at said toe and heel".
- b. "whose are is swept from heel to toe of said club face as described in Figure 2".

Though it is not correct to have a figure referred to in a claims as commented above, there is no figure 2 identical in Exhibits 1 and 2 as disclosed in this application.

- c. "a heel to toe bulge defined by a radius". There are curved faces but none of the pages of Exhibits 1 and 2 disclose the curve having a radius (i.e. circular shape).

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen L. Blau whose telephone number is (571) 272-4406. The examiner can normally be reached on Mon - Fri 10:00 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on (571) 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

4 December 2006


STEPHEN BLAU
PRIMARY EXAMINER